

REMARKS

Claims 1-9 and 11-17 are all the claims pending in the application. By this Amendment, Applicant is amending claims 1 and 14, and canceling claims 3, 8, 9, 11, 12, 13, and 15. No new matter is added.

The Examiner has not checked the appropriate box on the first page of any of the office actions to date so as to confirm approval of the drawings filed April 26, 2000. Applicant understands that the Examiner has no objection to these drawings, but kindly requests the Examiner to confirm his approval in Applicant's next response by checking the appropriate box.

1. Claims 12-17 rejected under 35 U.S.C. § 112, first paragraph for allegedly lacking support in the original disclosure

Claims 12-17 are rejected under 35 U.S.C. § 112, first paragraph, because the Examiner alleges that there is no "support in the original disclosure for the subject matter of new claims 12-17, and applicants have not specifically pointed out support for the new claims (MPEP 714.02)." Office Action at page 2. Applicant respectfully disagrees.

Support for the subject matter of claims 12 (now incorporated into claim 1), 14, 16, and 17 is readily apparent from Applicant's original disclosure and was also pointed out by Applicant in the last response. Claim 12 depends from claim 1 and further specifies that the sidewall portions are between the bead core and the tread. Applicant's discussion at pages 6-7 of the last Amendment points to the requisite support in the original disclosure. In particular, Applicant notes the quotation from page 8, lines 9-16 of the specification and original claim 1, which also forms part of the original disclosure. Applicant also notes that Figs. 1 and 2 explicitly show this feature.

Claim 14 depends from claim 1 and further specify that each tire includes a bead core and a bead filler radially outward of the bead core, and that the reinforcing member extends radially outward beyond the bead filler. Original figures 1 and 2 explicitly show this feature.

Claims 16 and 17, which depend from claim 1 and specify that the first and second tire zones of the same tire have the same rigidity in the radial direction, while the rigidity in the circumferential direction remain different as claimed. At pages 10-11 of Applicant's last response, Applicant pointed to the support in the original disclosure for this feature.

The Examiner's rejection of claims 12-17, under 35 U.S.C. § 112, first paragraph, as lacking support in the original disclosure is, therefore, believed to be incorrect. Indeed, the Examiner's Office Action does not even address Applicant's discussion of the support in the original disclosure noted above.

In view of the foregoing clarification regarding the adequate support in the original disclosure, the Examiner is kindly requested to reconsider and withdraw the rejection of claims 12-17 under 35 U.S.C. § 112, first paragraph.

2. *Claims 1-9 and 11-17 rejected under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the enablement requirement*

The Examiner's grounds of rejection here are the same as those set forth in the last Office Action. Namely, the Examiner takes the position that because there is no definition by the Applicant in the original disclosure of the boundary between the "sidewall portions" and the adjacent "bead portions" and "tread portion," one of ordinary skill in the art would not know how to provide the claimed reinforcing members in "a tire zone including at least each of the

sidewall portions”. Office Action of November 21, 2002 at pages 2-3. Furthermore, in response to Applicant’s traversal of this rejection made in the last Amendment, the Examiner states:

applicants erroneously argue that the original disclosure’s reference to the bead portions requires them to stop at the bead cores, when in fact there is clear evidence on the record (for example *The Story of Tire Beads and Tires*) that one of ordinary skill in the art would be aware of a multitude of possible bead portion constructions depending on the desired components and therefore would not know, without more, exactly where the “bead portion” ends and the “sidewall portion” begins.

Office Action at page 2. Applicant respectfully disagrees.

First, at a minimum, one skilled in the art would have known that the bead itself is used to sustain the air pressure and fit (i.e., anchor) the tire to the wheel rim; and, therefore, the bead is not part of the sidewall. *The Story of Tire Beads and Tires* provides no disclosure that contradicts this point.

Second, claims 12 and 13 further specify the location of the sidewall portions as being at least between the bead core and the tread. Claims 14 and 15 further specify that the reinforcing member extends radially outward beyond the bead filler. Applicant submits that one skilled in the art would know how to implement the claimed invention without undue experimentation, and that the Examiner is requiring more than the statute and case law require for enablement. Moreover, the Examiner’s rejection is conclusory and not based on fact. Even though *The Story of Tire Beads and Tires* may disclose various bead portion configurations, one skilled in the art would still understand how far to extend the reinforcing member with sufficient precision in order to achieve Applicant’s invention and without the need for conducting undue experimentation.

Similarly, one skilled in the art would understand where the tread portion ends, even though, for example, the tire may have different tread configurations.

In view of the foregoing, Applicant submits that the disclosure is sufficiently enabling, and the Examiner is kindly requested to reconsider and withdraw the rejection of claims

3. *Claims 1-9 and 11-17 rejected under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the written description requirement*

The Examiner grounds of rejection here are the same as those set forth in the last Office Action. Namely, the Examiner again incorrectly bases this rejection on the grounds that there lacks a description of the defined boundaries between the “sidewall portions” and the adjacent “bead portions” and “tread portion,” as discussed in the previous Section 112(1) rejection. As Applicant responded in the last Amendment, the Examiner’s rejection is legally incorrect. Only when the scope of a claim has been changed, e.g., during prosecution of the patent application, do questions of compliance with the description requirement arise. Since the recited subject matter relied upon by the Examiner to reject the claims under 35 U.S.C. § 112, first paragraph, are in the claims as originally filed with the application (at least claim 1), this rejection is incorrect as a matter of law. The Examiner is kindly requested to directly address this issue in the next response and to make the next response non-final, since the Examiner did not address in the July 1, 2003 Office Action.

4. *Claims 1-9 and 11-17 rejected under 35 U.S.C. § 112, second paragraph for allegedly being indefinite*

The Examiner bases this rejection on the belief that there lacks a description of the defined boundaries between the “sidewall portions” and the adjacent “bead portions” and “tread

portion.” Office Action at page 3. For the reasons set forth above in response to the Section 112, first paragraph, rejections, Applicant maintains that the claims are sufficiently definite when construed by the skilled artisan.

As for the alleged minor improper antecedent basis problems, Applicant is amending claims 12-15 to overcome this rejection.

If the Examiner continues to disagree with the Applicant regarding the Section 112 first and second paragraph rejections, the Examiner is kindly requested to telephone the undersigned attorney to discuss these issues and possible minor claim amendments that would resolve the disagreement.

5. *Prior Art Rejections*

The prior art rejections are summarized as follows:

1. Claims 11 and 13 are rejected under 35 U.S.C. § 102(b) as being anticipated by Oshima (5,620,538).

2. Claims 1-6, 9 and 11 are rejected under 35 U.S.C. § 102(b) as being anticipated by British Patent Specification 1,115,834.

3. Claims 1-6, 9 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over British Patent Specification 1,115,834 in view of *The Story of Tire Beads and Tires*.

Once again, claims 7 and 8 are not rejected on prior art grounds. The Examiner has not clarified the status of claim 9, which depends from claim 8, and, therefore, cannot be rejected on prior art grounds unless claim 8 is also rejected on prior art grounds. The Examiner is kindly requested to clarify the status of claim 9.

Claim 12 is not rejected on prior art grounds, and Applicant has amended independent claims 1 to include the limitations of claim 12. Accordingly, claim 1 and dependent claims 2, 4, 7, 14, 16, and 17 are distinguishable over the prior art, and the Examiner is kindly requested to withdraw the prior art rejections of these claims.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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